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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/295,826 | 04/21/1999 | TODD R. COLLART | IACTP007 | 7629 |

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DISCOVISION ASSOCIATES
INTELLECTUAL PROPERTY DEVELOPMENT
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| EXAMINER | |
|---|---|
| WINTER, JOHN M | |
| ART UNIT | PAPER NUMBER |
| 3621 | |

DATE MAILED: 02/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/295,826 | COLLART, TODD R. | |
| | Examiner | Art Unit | |
| | John M Winter | 3621 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *4/21/1999* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4,5,6,10 .13,16*
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

Claims 1-20 have been examined.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6,8,10,11-16,18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gracenote.com (New Media pioneers Ann Greenberg and Ty Roberts join CDDB.Com) in view of Archibald et al. (US Patent 5,825,883).

As per claim 1,

Gracenote.com discloses a method for permitting selective access to data based on an identifier stored on an electronic storage medium, comprising the steps of

reading the identifier of the electronic storage medium upon being input into a computer by a user;(Gracenote.com, paragraph 7)

verifying the identifier in a separate database; (Gracenote.com, paragraph 7)

Gracenote.com does not explicitly disclose collecting a payment for use of content on the electronic storage medium Archibald et al. ('883) discloses collecting a payment for use of content on the electronic storage medium. (figure 14) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracenote.com method with the Archibald et al method in order to collect a payment for use of content on the electronic storage medium in order to reduce the amount of revenue lost because of rampant piracy of digital materials.

Claim 11 is in parallel with claim 1.

As per claim 2,

Gracenote.com discloses the method for permitting selective access to data based on an identifier stored on an electronic storage medium as recited in claim 1,

wherein the identifier is verified in the separate database after the user effects a remote link between the computer and the separate database. (Gracenote.com, paragraph 7)

Claim 12 is in parallel with claim 2.

As per claim 3,

Gracenote.com discloses the method for permitting selective access to data based on an identifier stored on an electronic storage medium as recited in claim 1,

Gracenote.com does not explicitly disclose wherein the verification includes combining identifier information associated with the identifier and user information associated with the user. Archibald et al. ('883) discloses wherein the verification includes combining identifier information associated with the identifier and user information associated with the user (column 6, lines 33-47) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracenote.com method with the Archibald et al method of combining identifier information associated with the identifier and user information associated with the user in order to simplify record keeping procedures by merging customer and transaction data.

Official Notice is taken that "looking up both the identifier information and the user information on one or more databases to verify payment information" is common and well known in prior art in reference to electronic transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to look up both the identifier information and the user information on one or more databases to verify payment information because reduces the chances of the transaction being mishandled due to a error in retrieving data.

Claim 13 is in parallel with claim 3.

As per claim 4,

Gracenote.com discloses the method for permitting selective access to data based on an identifier stored on an electronic storage medium as recited in claim 1,

Gracenote.com does not explicitly disclose storing a record of the transaction in a database. Archibald et al. ('883) discloses storing a record of the transaction in a database (column 6, lines 48-59; also figure 3) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracenote.com method with the Archibald et al method of storing a record of the transaction in a database in order to simplify record keeping procedures.

Claim 14 is in parallel with claim 4.

As per claim 5,

Gracenote.com discloses the method for permitting selective access to data based on an identifier stored on an electronic storage medium as recited in claim 1,

wherein the computer is remotely coupled to the separate database via a network. (Gracenote.com, paragraph 7)

Claim 15 is in parallel with claim 5.

As per claim 6,

Gracenote.com discloses the method for permitting selective access to data based on an identifier stored on an electronic storage medium as recited in claim 5.

Gracenote.com does not explicitly disclose the payment processing is conducted electronically in a secure manner. Archibald et al. ('883) discloses the payment processing is conducted electronically in a secure manner. (column 6, lines 48-67) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracenote.com method with the Archibald et al method of processing payments in a secure manner in order to promote consumer confidence by protecting sensitive account information.

Claim 16 is in parallel with claim 6.

As per claim 8,
Gracenote.com discloses the method for permitting selective access to data based on an identifier stored on an electronic storage medium as recited in claim 1.
wherein electronic storage medium is an optical disc.(Gracenote.com, paragraph 7)

Claim 18 is in parallel with claim 8.

As per claim 10,
Gracenote.com discloses the method permitting selective access to data based on an identifier stored on an electronic storage medium as recited in claim 1,
wherein the data is stored in a remote database.(Gracenote.com, paragraph 7)

Claim 20 is in parallel with claim 10.

Claims 7,9,17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gracenote.com (New Media pioneers Ann Greenberg and Ty Roberts join CDDB.Com) in view of Archibald et al. (US Patent 5,825,883) and further in view of Oshima et al (US Patent 6,081,785).

As per claim 7,
Gracenote.com discloses the method for permitting selective access to data based on an identifier stored on an electronic storage medium as recited in claim 5,
Gracenote.com does not explicitly disclose an electronic code is utilized to authorize use of the content on the electronic storage medium. Oshima et al ('785)discloses an electronic code is utilized to authorize use of the content on the electronic storage medium. (Figure 24b) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracenote.com method with the Oshima et al ('785) method of using an electronic code to authorize use of content on an electronic storage medium in order prevent piracy of digital materials.

Claim 17 is in parallel with claim 7.

As per claim 9,
Gracenote.com discloses the method for permitting selective access to data based on an identifier stored on an electronic storage medium as recited in claim 8.

Gracenote.com does not explicitly disclose the identifier is stored on a burst cut area of the optical disc. Oshima et al ('785) discloses the identifier is stored on a burst cut area of the optical disc. (column1, lines 36-50; also figure 18) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracenote.com method with the Oshima et al ('785) method of storing an identifier on a burst cut area of the optical in order prevent piracy of digital materials.

Claim 19 is in parallel with claim 9.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-10 of patent 6,453,420 in view of Archibald (US Patent 5,825,883)

Although the conflicting claims are not identical, they are not patenable distinct for the reasons stated below.

As per claims 1-20 of the present application, Claims 1-10 of patent 6,453,420 differ in that the recite the additional steps of "transferring the identifier to a location of a separate database by software on the device" and "precluding access to the data upon unsuccessful verification of the identifier". It would have been obvious to a person of ordinary skill in the art to modify claims 1-10 of patent 6,453,420 by removing these limitations. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963) Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

Claim 1 of patent 6,453,420 does not disclose collecting a payment for use of content on the electronic storage medium Archibald et al. ('883) discloses collecting a payment for use of

content on the electronic storage medium. (figure 14) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of patent 6,453,420 with the Archibald et al method in order to collect a payment for use of content on the electronic storage medium in order to reduce the amount of revenue lost because of rampant piracy of digital materials.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW
February 4, 2003

JOHN HAYES
John W. Hayes
Primary Examiner